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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/612,196

Filing Date: July 02, 2003

Appellant(s): FITZPATRICK, KEITH

Brian McGuire
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/23/2009 appealing from the Office action mailed 7/10/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained on the top of page 6 the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,753,085	FITZPATRICK	5-1998
EP 0 960 975	DAVENPORT	12-1999

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 1-11, 13 and 32-40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 5,753,085 to FitzPatrick.**

Regarding claims 1-11, 13 and 32-40, FitzPatrick discloses a long nip press belt for a papermaking machine comprising a textile substrate comprising a plurality of individual layers coated on both sides and impregnated with a polymeric resin (see entire document including Figure 6, column 3, line 57 through column 4, line 15, and column 5, lines 38-49). The textile substrate includes textile components such as monofilaments, continuous fine filaments or staple fibers having non-circular cross sections with a plurality of lobes (column 4, lines 27-31). The laminate is held together by chemical bonding (abstract). The textile can be woven and/or nonwoven (column 4, lines 11-15). The polymeric resin material may be polyurethane (column 3, lines 63 and 64). The filaments may be interwoven from machine direction and cross-machine direction (column 4, lines 64-67).

It is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show an unobvious difference between the claimed product and the prior art product.

Claim Rejections - 35 USC § 103

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,753,085 to FitzPatrick as applied to claims 1-11, 13 and 32-40 above, and further in view of EP 0 960 975 to Davenport.

FitzPatrick appears to be silent regarding the outer surface having grooves or blind-drilled holes, but Davenport discloses that it is known in the art to supply the substrate with grooves or blind-drilled holes for the temporary storage of water (see entire document including [0031] and [0032]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include grooves or blind-drilled holes in the substrate, motivated by a desire to supply the substrate with temporary storage of water.

(10) Response to Argument

Claims 1-11, 13 and 32-40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 5,753,085 to FitzPatrick.

The appellant asserts that FitzPatrick fails to teach or suggest a multilayer structure. The examiner respectfully disagrees. Figure 6 clearly illustrates the multilayer textile structure cross-section comprising first and second layers of longitudinal filaments (48) and a middle layer of transverse filaments (46). A resin coating (50) is coated on both sides of the multilayer textile structure (column 5, lines 38-49) and impregnates the multilayer textile structure (see Figure 6 wherein diagonal lines representing the resin material (50) run continuously through the multilayer structure and also column 3, lines 57-63 wherein it is explicitly disclosed that the resin material impregnates the textile substrate). It is also noted that the appellant admits that Figure 6 illustrates a multilayer structure wherein each layer comprises yarn (textile) material (see appeal brief page 14, lines 6-7 and page 15, lines 17-18).

The appellant asserts that FitzPatrick fails to teach or suggest the currently claimed substrate because FitzPatrick combines individual layers and then impregnates the combination of layers rather than first impregnating the layers (i.e. forming preformed layers) and then combing them. The examiner respectfully disagrees. Although the method disclosed by FitzPatrick is different than the product-by-process limitations claimed by the appellant, the current claims are drawn to a product (a substrate or a belt), not a process. The patentability of a product does not depend on its method of production. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. If the product in the product-by-process claim is the same as or obvious from a product of

the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter.

In response, the appellant asserts that the process disclosed by FitzPatrick results in a patentably distinct structure. The appellant asserts that the currently claimed product-by-process limitations cause a “fairly complete lamination between adjacent layers, at nearly 100 percent coverage.” Appellant’s argument is not persuasive for a few reasons. Firstly, the feature upon which applicant relies (i.e., fairly complete lamination between adjacent layers, at nearly 100 percent coverage) is not recited in the rejected claims. On the contrary, claim 1 does not even mention the layers being combined or laminated. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Secondly, the appellant fails to provide evidence to support the assertion that the currently claimed product-by-process limitations necessarily result in “fairly complete lamination between adjacent layers, at nearly 100 percent coverage.” Rather, the current claims simply state that each preformed layer is coated/impregnated with resin or rubber material. It is noted that the current claims do not even require that each preformed layer is 100% coated or 100% impregnated. It is well settled that unsupported arguments are no substitute for objective evidence. *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). Thirdly, the appellant has failed to show that the process disclosed by FitzPatrick results in anything less than “fairly complete lamination

between adjacent layers, at nearly 100 percent coverage.” On the contrary, the substrate of FitzPatrick appears to include fairly complete lamination between adjacent layers, at nearly 100 percent coverage. Figure 6 clearly shows the resin material (50) coating the upper and lower textile layers with 100% of the upper and lower textile layer surfaces being covered with said resin material.

The appellant also asserts that the currently claimed product-by-process limitations allow for making endless belts having properties such as different properties on the face and back sides of the belt. The appellant asserts that such belts may be produced by varying the impregnating resin material of each layer while the single resin coating of FitzPatrick is not capable of forming distinct resin layers. Appellant’s argument is not persuasive for a few reasons. First, the current claims do not require “distinct” (different) resin material in each layer. Therefore, the feature upon which appellant relies (i.e., distinct resin material in each layer) is not recited in the rejected claims. Secondly, claim 1 requires “a polymeric coating or impregnating material or rubber material that is part of each of said individual preformed layers.” Therefore, not only do the current claims not require layers of different resin material, but the current claims actually require that the same polymeric or rubber material is part of each of said coated/impregnated individual preformed layers.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,753,085 to FitzPatrick as applied to claims 1-11, 13 and 32-40 above, and further in view of EP 0 960 975 to Davenport.

The appellant fails to separately argue the claim.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Andrew T Piziali/
Primary Examiner, Art Unit 1794

Conferees:

/D. Lawrence Tarazano/
Supervisory Patent Examiner, Art Unit 1794

/William Krynski/

Primary Examiner